

02-24-04

1635

**PATENT**  
Attorney Docket No. 212241

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Ts'o et al.

Examiner: Mary M. Schmidt

Application No. 09/888,164

Group Art Unit: 1635

Filed: June 22, 2001

For: LIGANDS TO ENHANCE  
CELLULAR UPTAKE OF  
BIOMOLECULES

**REQUEST FOR WITHDRAWAL AS ATTORNEY  
PURSUANT TO 37 CFR § 10.40(c)**

**APPROVED**

*[Signature]*  
SPE, TC/600  
3/15/04

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

1. The attorneys and the law firm of Leydig, Voit & Mayer, Ltd. (Customer No. 23460) named in the declaration filed with respect to this patent application respectfully request permission to withdraw from all further responsibility in this case in accordance with 37 CFR § 1.36.

2. The last known mailing address of the client is Cell Works, Inc., 6200 Seaforth Street, Holabird Business Park, Baltimore, MD 21224-6506.

3. The basis for the request for withdrawal is 37 CFR § 10.40(c)(1)(vi). The client has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time and has thus failed to honor the agreement in the executed retainer letter. A copy of the executed retainer letter is enclosed (Exhibit A). In particular, Section 4 of the retainer letter specifies that the firm's invoices are to be paid immediately upon receipt and not later than 30 days after receipt of the invoice. Despite numerous requests by phone and by mail, as of November 30, 2003, the client had failed to pay invoices (for different matters) dated June 25, 2003, July 25, 2003, August 25, 2003, September 25, 2003, and October 25, 2003. A copy of the November 30, 2003 accounting statement reminder is enclosed (Exhibit B). Since the client

In re Ts'o et al.  
Application No. 09/888,164

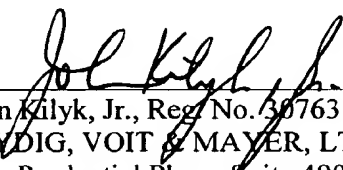
failed to pay, for an unreasonable period of time, one or more rendered bills, and since the client failed to honor the agreement in the retainer letter, withdrawal of representation is appropriate.

4. There has been no Office Action issued in the application, so there is no response due in the application as of the date of submitting this request.

5. The client was advised of the need to appoint new counsel over two months ago, but despite repeatedly indicating it would provide the name and address of new counsel to the undersigned's law firm, the client has not provided the information. A copy of a letter to the client dated January 27, 2004, reminding the client of the need to identify new counsel and the need to notify the U.S. Patent and Trademark Office, is enclosed (Exhibit C).

6. This request for withdrawal is enclosed in triplicate.

7. The signature of an authorized attorney on behalf of all the attorneys withdrawing:



---

John Kilyk, Jr., Reg. No. 30763  
LEYDIG, VOIT & MAYER, LTD.  
Two Prudential Plaza, Suite 4900  
180 North Stetson Ave.  
Chicago, Illinois 60601-6780  
(312) 616-5600 (telephone)  
(312) 616-5700 (facsimile)

Date: February 23, 2004

7.

## LAW OFFICES

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TWO PRUDENTIAL PLAZA, SUITE 4900  
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March 8, 2001

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M. MICHAEL HARTMANN  
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## OF COUNSEL

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PAUL L. AHERN  
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## TECHNICAL ADVISORS

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HEATHER R. KISSLING  
DAVID M. MOTT  
KRISTOPHER T. LYNCH  
LEONDO R. PHIFER  
DIAO ZHANG  
KRISTEN J. HARRELL

ALL RESIDENT IN CHICAGO OFFICE EXCEPT AS NOTED  
\*RESIDENT IN WASHINGTON OFFICE \*\*RESIDENT IN ROCKFORD OFFICE  
ALL LICENSED IN STATE OF RESIDENCY OFFICE EXCEPT AS NOTED  
†ADMITTED IN VIRGINIA ONLY

Ms. Denise Bernstein  
Cell Works  
6200 Seaforth St.  
Baltimore, MD 21224

## Re: Terms of Legal Representation

Dear Denise:

We are pleased that you have engaged our firm, Leydig, Voit & Mayer, Ltd., to represent you. This letter sets forth the terms of that representation.

## 1. Client and Scope of Representation

Our firm's client is Cell Works (also referred to as "you" herein). Leydig, Voit & Mayer, Ltd. will represent you in connection with intellectual property matters. Your continuing requests for and receipt of our firm's services acknowledges your agreement with the terms of representation set forth herein. This document sets forth all the terms of our firm's representation of you, and these terms cannot be modified except in writing by the legal representatives of our firm and you.

## 2. Fees and Expenses

The fees of our firm will be based upon our firm's determination of the value of our firm's services and the expenses (including out-of-pocket disbursements) our firm incurs as a

Denise Bernstein

March 8, 2001

Page 2

result of our firm's representation of you. Our firm determines the value of our firm's services primarily through analysis of the time required by the lawyers and legal assistants of our firm to handle matters relating to the representation at nominal hourly rates based upon the experience and respective contributions of such lawyers and legal assistants. The current hourly rates for attorneys and technical assistants in our firm range from \$110 to \$375, and the hourly rates for legal assistants range from \$50 to \$100. The assigned hourly rates are adjusted from time-to-time (generally once a year) and are subject to change during the course of the representation. Any estimate of fees and expenses is an estimate only and not a limitation on fees and expenses.

3. *Retainer*

Our firm may require a retainer from you before commencing certain work on your behalf. If such a retainer is required, our firm will so advise you and that retainer will be applied as a credit against our firm's invoices.

4. *Invoices*

Our firm will bill you on a monthly basis (dated the 25th day of each month) for our firm's fees in connection with the representation of you during the preceding month. Additionally, our firm's invoices can include significant anticipated expenses for the following month. Our firm will forward its monthly invoices and statements to your attention, unless otherwise directed. Payment of our firm's invoices is due immediately and is in no way contingent on the ultimate outcome of any course of action. It is our firm's understanding that you will pay our firm's invoices within thirty days of receipt. Failure to timely pay the firm's invoices can result in our firm's terminating its representation of you.

5. *Retention of Other Professionals*

The particular nature of our firm's representation of you may require the retention of other professionals, such as local counsel, expert witnesses, and foreign associates. When our firm deems it appropriate to the nature of our firm's representation of you, and unless you instruct us otherwise, our firm will retain such other professionals on your behalf. However, you acknowledge that such other professionals are engaged by you and that you are responsible for fees and expenses incurred by them.

Denise Bernstein  
March 8, 2001  
Page 3

6. *Representations as to Outcome*

Our firm may express views concerning the outcome of various courses of action. While our firm will always endeavor to give you a candid and accurate assessment in that respect, any such views will be an expression of our firm's opinion based on information available to us at the time and will not be any promise or guarantee.

7. *Conflicts*

Our firm represents many other companies and individuals. It is possible that some of our firm's present or future clients may have transactions and/or disputes with you. You acknowledge that our firm's representation of you does not prevent our firm from representing other clients adverse to you as long as their transactions and/or disputes with you do not involve the disclosure or use of confidential information of or concerning you obtained as a result of our firm's representation of you that, if known to such other clients, could be used to your material disadvantage.

8. *Term of Representation*

Either of us may terminate our firm's representation of you at any time for any reason, subject to the applicable rules of professional conduct and any court and patent office rules and regulations. Termination of our firm's representation of you does not relieve you from the responsibility to pay fees and expenses.

If you have any questions regarding the terms of our firm's representation of you at any time, please do not hesitate to contact our firm. We appreciate the opportunity to represent you, and we trust that our association will be pleasant and long-lived.

Very truly yours,

LEYDIG, VOIT & MAYER, LTD.



Carol Larcher, Ph.D.

CL/ekm

cc: Bruce M. Gagala  
Carleen Culleton (LVM Docketing) ✓

## Exhibit B

PLEASE  
REMIT TO  
CHICAGO OFFICE

LAW OFFICES  
LEYDIG, VOIT & MAYER, LTD.  
SUITE 4900 TWO PRUDENTIAL PLAZA  
CHICAGO, ILLINOIS 60601-8780  
(312) 616-5500

WASHINGTON, D.C.  
ROCKFORD, ILLINOIS

WIRE FUNDS TO: AMERICAN NATIONAL BANK & TRUST CO. OF CHICAGO  
120 SOUTH LA SALLE STREET, CHICAGO, ILLINOIS 60603-3400 ACCOUNT NO. 885975

CELL WORKS, INC.  
ATTN: MAX OPPENHEIMER  
ROOM 128  
6200 SEAFORTH STREET  
BALTIMORE, MD 21224

Client Number  
C2121 -000

STATEMENT ----  
November 30, 2003

Atty: JMJ

The following is a listing of our outstanding invoices as of this date. Note the summary of status of the invoices. We would appreciate your attention to any invoices earlier than those listed as "current." If you need any copies or find any discrepancies, please contact me at:

Phone: (312) 616-5715 / E-mail: jsimmons@leydig.com / Fax: (312) 616-5700

Joni Simmons

NUMBER	INVOICE AMOUNT	DATE	PAYMENTS OR ADJUSTMENTS	REMAINING BALANCE
792066	\$9,196.41	6/25/2003		\$9,196.41
796458	13,453.22	7/25/2003		13,453.22
801743	1,288.71	8/25/2003		1,288.71
809102	7,298.97	9/25/2003		7,298.97
814917	3,168.53	10/25/2003		3,168.53
TOTAL BALANCE .				\$34,405.84

#### SUMMARY OF STATUS

Current Invoices.....	
31-60 Days Now Due....	\$3,168.53
61-90 Days Past Due...	\$7,298.97
91-120 Days Past Due..	\$1,288.71
Over 120 Days Past Due	\$22,649.63

LAW OFFICES  
**LEYDIG, VOIT & MAYER**  
 A PROFESSIONAL CORPORATION

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 WASHINGTON, D.C. 20005-3960

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January 27, 2004

*Via Facsimile*  
*Confirmation via Federal Express*

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 DENNIS R. SCHLEMMER  
 GORDON R. COONS  
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 RACHEL J. POTENPA KATHLEEN M. HELM-STCHOWSKI  
 JULIE J. HONG

ALL RESIDENT IN CHICAGO OFFICE EXCEPT AS NOTED  
 \*RESIDENT IN WASHINGTON OFFICE \*\*RESIDENT IN ROCKFORD OFFICE  
 \*RESIDENT IN SEATTLE OFFICE  
 \*\*ADMITTED IN CALIFORNIA ONLY

Karen Hudson  
 Cell Works, Inc.  
 6200 Seaforth Street  
 Holabird Business Park  
 Baltimore, MD 21224-6506

Re: Cell Works Files

Dear Karen:

Please find attached a list of all the files at our firm pertaining to our firm's representation of Cell Works, Inc. The list includes the applicable due dates for the next actions in various patent applications. This list of due dates is not exhaustive, and you should contact the your new patent counsel, the U.S. Patent and Trademark Office, and/or the relevant foreign associates for a more complete listing of due dates.

Please note that some of the listed files pertain to cases apparently assigned to both Cell Works, Inc., and Johns Hopkins University (JHU).

In accordance with your and Ted McCarthy's instructions, please find enclosed (with the confirmation copy of this letter) the files bearing the following LVM reference numbers that are being transferred to Cell Works, Inc. (CWI) at this time:

211726	225776
211728	225778
214469	225779
214470	

The files bearing LVM reference numbers 225776, 225778, and 225779 relate to unfiled US applications. The patent application with LVM reference number 225776, entitled "Organ-targeted therapy and individual characterization for cancer management," is indicated to



Karen Hudson  
January 27, 2004  
Page 2

have a filing deadline of February 12, 2004. The patent application with LVM reference number 225778, entitled "Standardized evaluation of therapeutic efficacy based on cellular biomarkers," is indicated to have a filing deadline of February 27, 2004. The patent application with LVM reference number 225779 has not yet been prepared. The file and reference number appear to have been set up for a future possible patent application, for which we have no further information (e.g., a title or pending action).

The file bearing our reference number 211726 relates to an issued US patent, patent number 5,994,517, and there will be annuity payments due as noted in the list. The file bearing our reference number 211728 relates to an abandoned application, US application number 09/888,164. The files bearing our reference numbers 214469 and 214470 relate to provisional patent application numbers 60/250,139 and 60/250,126, respectively, and these matters are closed.

CWI is responsible for any and all further handling (e.g., revising and/or filing) of these matters (e.g., the unfiled applications and the annuity payments for US Patent Number 5,994,517), and Leydig, Voit & Mayer Ltd. (LVM) will not be taking any further action with respect to these matters. This means, for example, that LVM will not be revising and/or filing the referenced patent applications, and LVM will not be responsible for any possible loss of rights relating to the failure to file applications (in the U.S. Patent and Trademark Office or in any other patent office) relating to the subject matter concerning these files.

According to our records, none of the 7 files listed above (i.e., the files that are being sent to Cell Works, Inc.) relate to matters wherein JHU may have an ownership interest.

Since our records suggest that JHU may have an ownership interest relating to some of the other patent applications referenced in the attached list, the other files are not being sent to CWI at this time even though CWI also has an ownership interest relating to these other patent applications and CWI is financially responsible for the legal services relating to these other matters. Out of an abundance of caution, we are in the process of contacting JHU regarding sending these other files to CWI. However, since, as you know, LVM will no longer represent CWI and will not be responsible for any further handling of these or other matters on behalf of CWI, we encourage you to also contact JHU and/or new counsel so that these other files can also be transferred in an expeditious manner. We also remind you that LVM will no longer be responsible for any foreign associate expenses incurred hereafter that are associated with the patents and patent applications of CWI.

Please note that the attached list refers to two pending US patent applications, and the files associated with these patent applications are not being transferred at this time. We will coordinate with you as to the most efficient way to notify the U.S. Patent and Trademark Office (USPTO) of the change in representation in these two cases. After the PTO has acknowledged the change in representation, we will forward our files with respect to these two pending US

Karen Hudson  
January 27, 2004  
Page 3

patent applications to CWI or its new counsel. If you prefer that we merely send the files to you without your providing us the name of new counsel, please let us know, and we will do so. These two pending US patent applications are described below:

The first pending US patent application bears LVM reference no. 212241, and is the US national phase of PCT/US02/19908, entitled "Ligands to enhance cellular uptake of biomolecules."

The second pending US patent application bears LVM reference no. 214654 (CWI ref. CW-400), and is entitled "Conjugates of glycosylated/glactosylated peptide, bifunctional linker and nucleotidic monomers/polymers, and related composition and methods of use." The application (App. No. 09/998,497) is pending at the USPTO, and an Office Action was issued on December 24, 2004, and this Office Action was forwarded to you. The deadline to respond to the Office Action without incurring a fee for an extension of time is March 24, 2004. Please note an Assignment has not been filed with respect to this patent application. Our records suggest that this patent application is co-owned by CWI and JHU. Please confirm this information, and we will prepare and attend to the filing of the appropriate Assignment(s).

The files on the attached list represent all of the files at our firm pertaining to our firm's representation of CWI. As we have discussed, and as noted above, LVM will no longer represent CWI and will not be responsible for any further handling of these or other applications on behalf of CWI. Additionally, LVM will no longer be responsible for any foreign associate expenses incurred hereafter that are associated with the patents and patent applications of CWI.

Our firm is in the process of preparing appropriate papers with the USPTO for withdrawing from the handling of the U.S. patents and patent applications of CWI, and we will notify the relevant foreign associates that our firm is no longer representing CWI as regards foreign patents and patent applications. Accordingly, the USPTO and the foreign associates will be corresponding directly with CWI as regards its patent portfolio until such time that CWI provides the USPTO and foreign associates with contact information for new counsel for CWI. We will copy CWI on the aforementioned correspondence.

Although we will not be responsible for any further handling of any patents and patent applications on behalf of CWI after this transfer, we will forward any communications we receive from the USPTO and/or foreign associates to you. Please note, however, that LVM will not be responsible for handling any substantive matters on behalf of CWI in response to such communications. Similarly, LVM will not be responsible for the payment of any invoices for services incurred on behalf of CWI after LVM ceases to represent CWI. Lastly, CWI remains responsible for promptly paying any invoices for appropriate services rendered by LVM or foreign associates before LVM ceases to represent CWI.

Karen Hudson  
January 27, 2004  
Page 4

Please sign the enclosed copy of this letter and return it to us as acknowledgment of receipt of the files and responsibility for the same.

Very truly yours,

LEYDIG, VOLT & MAYER



Jeremy M. Jay

Cell Works, Inc. has received the referenced files and acknowledges responsibility for all matters concerning the cases.

---

Karen Hudson  
Executive Administration Manager  
On behalf of Cell Works, Inc.

---

Date

cc: Paul Ts'o (w/listings only)  
Ted McCarthy (w/listings only)

Karen Hudson  
January 27, 2004  
Page 4

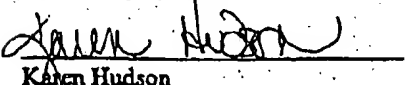
Please sign the enclosed copy of this letter and return it to us as acknowledgment of receipt of the files and responsibility for the same.

Very truly yours,

LEYDIG, VOLT & MAYER

  
Jeremy M. Jay

Cell Works, Inc. has received the referenced files and acknowledges responsibility for all matters concerning the cases.

  
Karen Hudson  
Executive Administration Manager  
On behalf of Cell Works, Inc.

2-5-04  
Date

cc: Paul Ts'o (w/listings only)  
Ted McCarthy (w/listings only)